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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,679	12/19/2000	J. Stuart Cumming	P02087US1	6074

34313 7590 11/29/2004

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EXAMINER
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ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/740,679	CUMMING, J. STUART	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eduardo C. Robert	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004 and 13 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 53-102 and 104-106 is/are pending in the application.
- 4a) Of the above claim(s) 53-102 and 105 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 104 and 106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/19/00 & 7/29/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Election/Restrictions***

Applicant's amendments filed on July 29, 2004 and August 13, 2004 amending independent claims 53, 90, and 105 have changed the status of the claims. It is noted that applicant elected on October 11, 2002 the Species IX, i.e. Figure 18, and comparison of the amended claims with Figure 18 and the specification shows, however, that the species of Figure 18 does not have a solid flexible refractive optic to function as a single optic as required in amended claims 53, 90, and 105. Moreover, this limitation appears to be new matter since the specification as originally filed does not disclose a solid flexible refractive optic to function as a single optic. The specification only discloses a refractive error in the eye of the patient, e.g. "The method may be utilized to replace a natural lens from which a cataract has been removed and to correct a refractive error in the eye of a patient who previously wore glasses in order to enable the patient to see well without glasses. For example, the invention can be utilized to correct refractive errors and restore accommodation to persons in their mid-40's who require reading glasses" (see Paragraph 0033 of the publication of this application). The other place in the specification that applicant mentions the term "refractive" is in Paragraph 0084 of the publication of this application, wherein applicant talks again about the possibility of correction of refractive errors. However, there is no disclosure or suggestion of a "solid flexible refractive optic" or that the embodiment of Figure 18 includes this characteristics. Furthermore, there is not even suggestion in the specification for the recitations of "to function as a single optic", it is

Art Unit: 3732

noted that the specification recites the term "single" only in Paragraph 0016 of the publication of this application, wherein applicant talks about the prior art.

The status of the claims is the following;

Claims 53-102 and 104-106 are pending.

Claims 53-103 and 105 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species.

No claim is generic.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 104 and 106 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,197,059, over claims 1-8 of U.S. Patent No. 5,476,514, and over claims 1-42 of U.S. Patent No. 5,674,282.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the application and the claims of the patents '059, '514, and '282 lies in the fact that the patent claims includes more elements and are more

Art Unit: 3732

specific. Thus, the invention of the patent claims are in effect a "species" of the "generic" invention of the claims of the application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the application are anticipated by the claims of the patents '059, '514, and '282, they are not patentably distinct from the claims of the patents.

### ***Response to Arguments***

Applicant's arguments filed on July 29, 2004 and August 13, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument about the filing of a terminal disclaimer in due course to overcome the Double Patenting Rejection, it is noted that the examiner acknowledged applicant's intentions to file a terminal disclaimer, however, the intention by itself does not overcome the Double Patenting Rejection.

In response to applicant's argument about the amendment to the claims, it is noted that the amendment to the claims made them not readable on the elected Species IX, i.e. Figure 18, and thus these claims have been withdrawn from further consideration as being directed to a nonelected Species (see Election/Restriction section above).

### ***Allowable Subject Matter***

Claims 106 and 104 would be allowable if a timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) is filed to overcome the double patent rejection set forth in this Office Action.

Art Unit: 3732

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

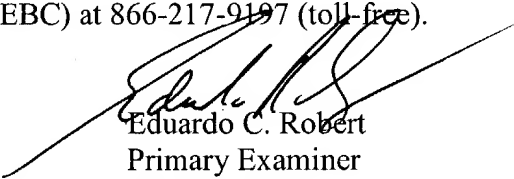
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571-273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.